

REMARKS

In an Office Action mailed on January 26, 2007, the Examiner rejected all of the pending claims (1-33) under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Applicants respectfully traverse the rejection of claims 1-33 for at least the following reasons. Concerning claim 1, the Examiner acknowledges that claim 1 “teaches a method for generating a timing signal.” (emphasis added). Despite having noted that claim 1 is directed to a method, the Examiner for some inexplicable reason concludes that claim 1 is directed to a signal and is thus non-statutory. Applicants respectfully submit that claim 1 is directed to a method for generating a signal and thus it falls squarely within the statutory class “process.” The “Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility,” (referred to as Guidelines) note that a claimed signal is not a ‘process’ under § 101 because it is not a series of steps.” Page 55. Claim 1 recites a series of steps and thus is clearly a process. Accordingly, claim 1 is directed to statutory subject matter.

Applicants respectfully submit that in evaluating whether claim 1 is directed to statutory subject matter, the Examiner must consider claim 1 as a whole. Indeed, the Federal Circuit has stated that “the dispositive inquiry is whether the claim as a whole is directed to statutory subject matter, it is irrelevant that a claim may contain, as part of the whole, subject matter which would not be patentable by itself.” *In re Alappat*, 33 F.3d 1526, 1543 (Fed. Cir. 1994). Thus, just because as part of the whole, claim 1, recites a signal, does not make claim 1 un-statutory. Accordingly, at least for this reasons, Applicants respectfully submit that claim 1 is directed to statutory subject matter.

In addition, the patentability of claim 1 is fully consistent with the reasoning of the Federal Circuit in *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352 (Fed. Cir. 1999). In *AT&T*, the Court addressed a claim directed to generating a message record (a signal), which comprises the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers. (*Id.* at 1354).

In analyzing this claim under 35 U.S.C. § 101, the Court noted that “AT&T’s claimed process employs subscribers’ and call recipients’ PICs as data, applies Boolean algebra to those data to determine the value of the PIC indicator, and applies that value through switching and recording mechanisms to create a signal useful for billing purposes.” (*Id.* at 1358) (emphasis added). The Court further noted that the “PIC indicator represents information about the call recipient’s PIC, a useful, non-abstract result that facilitates differential billing of long-distance calls made by an IXC’s subscribers.” *Id.* Thus, the Court in *AT&T* found a process directed to generating a signal patentable under 35 U.S.C. § 101. Applicants respectfully submit that consistent with the reasoning of the Federal Circuit in *AT&T*, claim 1, when considered as a whole, is directed to statutory subject matter.

Claims 2-15 depend, directly or indirectly, upon claim 1 and thus are patentable for at least the reasons given above with respect to claim 1.

Claim 16 is also directed to statutory subject matter since it is directed to a machine, *i.e.*, a communication receiver. The cited guidelines provide a definition of a machine and make it clear that “[a] modern definition of machine would no doubt include electronic devices which perform functions.” *Guidelines*, page 55. Claim 16 recites structures (which may include electronic devices), in means plus function format, for performing functions, including, generating a correlated signal, generating a phase error signal, and generating a timing signal. For similar reasons as given above with respect to claim 1, merely because claim 16 as part of the whole contains the term signal, does not make this claim un-statutory. Accordingly, for at least this reason, Applicants respectfully submit that claim 16 is patentable.

Claim 17 depends from claim 16 and thus is patentable for at least the reasons given above with respect to claim 16.

Claim 18 is also directed to statutory subject matter since it is directed to a machine, *i.e.*, a timing detector. Claim 18 recites modules (which may include electronic devices) for performing functions, including, correlating a received signal, deriving phase information of the correlated signal, and generating a timing signal. For similar reasons as given above with respect to claims 1 and 16, merely because claim 18 as part of the whole contains the term signal, does not make this claim un-statutory. Accordingly for at least this reason, Applicants respectfully submit that claim 18 is patentable.

Claims 19-33 depend, directly or indirectly, from claim 18 and thus are patentable for at least the reasons given above with respect to claim 18.

In view of the remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is requested to telephone the undersigned.

If Applicants have overlooked any additional fees, or if any overpayment has been made, the Commissioner is hereby authorized to credit or debit Deposit Account 503079, Freescale Semiconductor, Inc.

Respectfully submitted,

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